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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,939	01/26/2004	Joerg Mueller	CM2588CQ	9308
27752	7590	02/06/2006	EXAMINER	
THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION WINTON HILL TECHNICAL CENTER - BOX 161 6110 CENTER HILL AVENUE CINCINNATI, OH 45224			REICHLE, KARIN M	
			ART UNIT	PAPER NUMBER
			3761	
DATE MAILED: 02/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/764,939	Applicant(s) MUELLER ET AL.	
	Examiner Karin M. Reichle	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-22-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Europe on 7-26-01. It is noted, however, that applicant has not filed a certified copy of the European patent application as required by 35 U.S.C. 119(b).

The present application claimed it is a continuation of a European patent application in the transmittal papers, claimed the benefit of foreign priority on the same document in the original and first supplemental ADS and claimed the present application is a continuation of a PCT which claimed the benefit of priority to the same European application in the second supplemental ADS. Neither the original declaration nor the specification claimed any priority. No copy of the PCT showing receipt of a priority document therein nor a certified copy of the European patent have been received in the application to date.

Specification

Drawings

2. The drawings are objected to because the drawings are replete with informalities. For example, the geometric center points of the backsheet, i.e. A, the cuff, i.e. D, and the core as claimed should be denoted. The maximum length of the opening as claimed in claim 9 should also be denoted. The longest width of the cuff as claimed in claim 7 should be denoted. The total active length as claimed in claim 15 should be denoted. Figure 1 is inconsistent with the description thereof on page 4, line 18, i.e. partly shown in section but not described as such. Also see the next paragraph. Applicant should carefully review and revise, as necessary, the Figures. Applicant is thanked in advance for his/her cooperation in placing the Figures in proper form. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the dimensions L, Ls, Lc, Lr, B, C, H1, H2, H3, H4, Wb, Wc as claimed in claims 2-3, 7, 9 and 11, the transversely fixed position of the geometric center point of the core as claimed in claim 2, the fixed position fixed by the geometric center point of the core as claimed in claim 3, and the longitudinal connection area of the cuff and backsheet, the inner connection line and the outer connection line as claimed in claim 4 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Description

4. The abstract of the disclosure is objected to because terminology which can be inferred, i.e. "The invention relates to, should be avoided. On line 5, "that" (one occurrence) should be deleted. Correction is required. See MPEP § 608.01(b).

5. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: page 1, line 9, and page 2, lines 5 and 7-9.

6. The use of the trademark Pampers Premium (page 23, line 23) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

7. The disclosure is objected to because of the following informalities: The description is replete with informalities. For example: 1) Throughout the specification "The inventors" (all) and "the inventors" (all) should be avoided, i.e. the specification should be limited to a factual description of the claimed invention. 2) On page 2, line 30, "cuff" (first) should be deleted. 3)

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On page 9, line 21, should "H1" be --H2--? 4) On page 24, line 19, "2" should be --27--. 5) The description of the invention is at the very least inconsistent. For example, the claims call for a "sag-tolerable" cuff. However the definition of "sag-tolerable" at, e.g., page 2, lines 3-4 which describes such as requiring the cuff remain in contact is not the same as that at page 6, lines 8-17 which describes such as requiring at least close proximity but not necessarily contact. For another example, page 6, lines 17-19 disclose the fulfillment of the requirements as defined in any of the dependent claims would be "sag-tolerable" yet the abstract and page 2, lines 16-19 set forth that specific dimensions and relationships between the cuff and backsheet alone or in combination with the core define what is "sag-tolerable" and not all the dependent claims, e.g. claim 14, recite such dimensions or relationships. Continuing, page 16, lines 28-29, see also *infra*, set forth that certain forces are essential but such forces are not claimed at all. Page 25, lines 25-29, the paragraph bridging pages 26-27, page 27, lines 10-13 and claims 6 and 8 disclose still other features which define what is "sag-tolerable". With respect to the dimensions and relationships described as defining what is "sag tolerable", discussed *supra*, at page 7, lines 7-11, the shortened article portion and thus the shortened cuff portion are described as a certain percentage of the article formed by removing the ends of the article yet page 21, lines 22-26 appear to define such differently. Furthermore, how the dimensions, e.g. Ls and Lc and other dimensions dependent on such, e.g., H1, H2, H3, Lr, the length of the opening, certain ratios, are measured is described at, e.g., page 7, lines 22-24, page 8, lines 9-11 and page 16, lines 5-9 as including clamping the shortened length so as to not cover such so that the entire length is uncovered between the clamps. However, if the shortened length only includes such length because the rest has been removed, how can it be clamped as described? Similarly, note page 10,

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lines 29-30 and the methods described on page 6, line 30-page 10, line 28. How can the article be measured for L_s and/or L_c without elastically extending the material or performing the measurement on a material which is not flat? This lack of at least consistency is exacerbated by the drawings not showing any of the measurement dimensions as discussed supra and by other terminology and/or definitions. Note discussion supra. Additionally, are the longitudinal connection area claimed and the described zones 81 one and the same? Is the whole length of the active cuff, see, e.g., page 22, lines 10-13 and the total active length of the sheet in claim 15 one and the same? See MPEP 608.01(o), i.e. "The use of a confusing variety of terms for the same thing should not be permitted". Also, e.g., on page 4, lines 9-10 and in claim 12 it is set forth that the core and cuff are not joined to each other but the definition on page 5, lines 23-26 of "joined" includes indirect joining and the core and cuff are indirectly connected by the backsheet. The "means" to keep the cuff in close proximity as claimed in claims 6 and 8 has not been specifically defined. Therefore a complete, clear, and consistent description of the invention should be set forth. 6) The description should be carefully reviewed and revised, as necessary to overcome all the informalities. Applicant is thanked in advance for his/her in placing the specification in overcoming the informalities.

Appropriate correction is required.

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: antecedent basis for the terminology "means to....skin" as set forth in claims 6 and 8 should be set forth.

Claim Objections

9. Claims 2-15 are objected to because of the following informalities: In claims 2-15, line 1, “An” should be --The--. In claim 9, “maximum” appears to be redundant, see definition bridging pages 4-5. In claim 10, line 2, “having” and “each” should be reversed. This also applies to similar language in claim 11, line 1. In claim 15, line 1, “step” should be --steps--. On line 6, after “in”, --a-- should be inserted. On line 10, after “in”, --the-- should be inserted. In claims 2-3, lines 2-3, “which...portion” should be deleted and on line 4, “in a” should be deleted. In claim 3, line 4, “, fixed by” should be --at--. In claim 4, line 1, “, which has” (2nd) should be --with--, on line 2, “L,” should be --L and--, on line 5, “is” should be --are--, and on the last line, “, being” should be --equal to--. In claim 5, line 2, “, which has” should be --with--. In claim 6, line 1, “or” should be ---and/or--, lines 2 and 4, after “skin”, --in use-- should be inserted and on line 4, before “relaxed”, --a-- should be inserted. In claim 7, line 1, “or” should be --and/or-- and on line 2, “the longest” should be --a longest--. In claim 8, line 3, after “skin”, --in use-- should be inserted and before “relaxed”, --a-- should be inserted, and on line 4, “direction” should be --directions--. In claim 10, line 2, after “bands”, --extending-- should be inserted. In claim 11, second to last line, “such that” should be deleted. In claim 13, before “relaxed”, --a-- should be inserted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The first load and second unload forces critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.

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See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See page 16, lines 28-19 and discussion supra.

11. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As set forth in MPEP 2164.04, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. While the analysis and conclusion of a lack of enablement are based on the factors discussed in MPEP 2164.01(a) and the evidence as a whole, it is not necessary to discuss each factor in the written rejection. The language should focus on those factors reasons and evidence that lead the examiner to conclude the specification fails to teach how to make and use the claimed invention without undue experimentation or that the scope of enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

First, what is the claimed invention? As set forth in the independent claim the invention is an absorbent article having a backsheet, a core and a “sag-tolerable” anal and/or vaginal cuff which includes an opening. As best understood as described, see discussion supra in section 5) of paragraph 7, the backsheet, core, cuff and opening, i.e. the dimension and relationships thereof, are selected for use based on specific desired characteristics including “sag-tolerability”, shortened article length L, stretched shortened article length Ls, contracted shortened article length Lc and/or load/unload forces, etc. Therefore the claims also define the invention by the

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methods or tests used to determine such characteristics rather than claim the specific materials, numerical dimensions and relationships.

Second, since the claimed characteristics must be determined, e.g. by a test used to measure such, the scope of the claims is enabled to the extent the test, i.e. the method and equipment or parameters thereof, measuring such characteristic is disclosed or described.

In the instant application, as discussed supra, the tests used to measure the characteristics, e.g. L, Ls, Lc, unload forces, and thereby “sag tolerability, H1-H4, etc, are not clear, e.g. don’t know how to form the shortened length and clamp it as set forth. In other words, the tests, and thus the characteristics determined thereby, are not enabled and thus, the claims relying on such are not enabled. It is also noted that there is no one specific example of the claimed article, e.g. all the materials, numerical dimensions and relationships of a single exemplary article are set forth. Also see paragraph 10.

Third, the claims set forth the characteristics desired of the article rather than the specific materials, numerical dimensions and relationships. Therefore, relying on Ex parte Slob, 157 USPQ 172, such claims could cover any conceivable combination of materials, dimensions and relationships whether presently existing or which might be discovered in the future and which would impart the desired characteristic, e.g. “sag-tolerability”, i.e. the claims are too broad and indefinite since purport to cover everything having the characteristics regardless of its materials, dimensions and relationships (It should be noted that 35 USC 101 sets forth “Whoever invents or discovers any new and useful...composition of matter...may obtain a patent therefor...title, i.e. does not included compositions that have yet to be invented and discovered.)

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It is also noted that the claims do not set forth the article is only a backsheet, core, cuff and opening, i.e. the claims could cover any conceivable present or future article which includes at least such. Note again Ex parte Slob, supra.

For these reasons and evidence, the examiner concludes the specification fails to teach how to make and use the claimed invention without undue experimentation or that the scope of enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

12. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For the reasons set forth supra, the claims are indefinite, vague and too broad, see Ex parte Slob, supra.

Also, with respect to claim 2, a positive antecedent basis for “the ...H1” should be set forth. With respect to claim 3, a positive antecedent basis for “the ...H2” should be set forth. With respect to claim 4, a positive antecedent basis for “the ...H3” should be set forth. With respect to claim 5, a positive antecedent basis for “the shortest...adult” should be set forth. With respect to claim 7, a positive antecedent basis for “Ls” should be set forth. With respect to claim 11, a positive antecedent basis for “H4” should be set forth. With respect to claim 9, a positive antecedent basis for “the elasticized regions” should be set forth. In regard to claim 12, due to the definition “joined”, i.e. includes direct or indirect joining, it is unclear how the core and cuff are not joined to one another since it is also claimed it is interposed between the cuff and backsheet, i.e. indirectly connected. With respect to claim 15, a positive antecedent basis for

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“the active length” should be defined. Also are the sheets and opening in this claim and the sheet, cuff and opening in claim 1 one and the same, i.e. how many sheets and openings at a minimum are required?

Claim Language Interpretation

13. The claim language is interpreted in light of the definitions set forth at page 4, line 27-page 6, line 19 and page 2, line 3-4. Claims 6 and 8 recite “means to” “keep...skin”. This language is deemed not to invoke 35 USC 112, sixth paragraph since such does not satisfy the 3 prong test set forth in MPEP 2181, i.e. at least prong A), i.e. no “means for”. Claim 15 defines the article by the process of making, i.e. it is a product by process claim, see MPEP 2113, i.e. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” Therefore the product of claim 15 is interpreted to require the specifics of claim 1 from which it depends, i.e. the sheets and backsheet and cuff are deemed the same and the openings are deemed the same, the opening extends longitudinally, elastic material is along each longitudinal side of the opening and the cuffs and backsheet are attached along at least a part of their longitudinal edges. It is noted the end product is not required to have a wider first sheet/cuff.

Claim Rejections - 35 USC § 102/103

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tanzer '403.

See Figures 7-8, col. 5, lines 13-18, col. 6, lines 17-38, col. 7, lines 38-53, col. 13, lines 1-13, col. 15, lines 34-57, Figures 10-15, col. 16, line 48-col. 17, line 39 and col. 26, lines 24-25. '403 teaches an absorbent article, i.e. diaper 90, having a backsheet 50, a core 52, and a member 44, 92 connected to the backsheet along at least part of their longitudinal edges which member contains an opening 93 and elastic bands 84 of a width, e.g. 1 inch, i.e. 25 mm, along the edges of the opening. The core is positioned between the cuff and backsheet and is at least substantially not directly joined to the member 44, 92. The member, i.e. panels 92, has folds or pleats so that it has surplus material which allows the member to remain in contact with skin of the wearer. The surplus material and elasticity provide transverse and longitudinal extensibility and make the member larger than the backsheet in the crotch region. Therefore '403 clearly teaches all the claimed structure and capabilities, properties and functions thereof except for 1)

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the member being a “sag tolerable” “cuff” as claimed in the claims, 2) the dimensions/relationships, and thereby the tests or methods used to determine such as disclosed, as best understood, see discussion supra, as claimed in claims 2-5, and 9-11, 3) the extensibility of the member as claimed in claim 6, 4) the longitudinal folds as claimed in claim 13 and 5) the not joining of claim 12. With regard to 5), note again the definition of “joined” discussed supra. As shown in Figure 8 the member 44, 92 is at least substantially not directly connected to the core. As best understood due to the lack of clarity discussed supra, such is considered to meet the limitations of claim 12. Note also again col. 15, lines 39-41, the structure shown in Figures 12-13 which is similar to that in Figures 7-8 and also col. 16, lines 52-54, i.e. it would be obvious, if not already, to entirely not join the member and core. With regard to 1)-4), it is the Examiner’s first position that since ‘403 teaches a backsheet and core and a member which includes all the claimed structure and the structures are designed to perform similarly, i.e. maintain contact, there is sufficient factual basis to conclude that the structure of ‘403 also inherently defines a “sag-tolerable” “cuff”, as best understood, and longitudinal folds and inherently possesses the dimensions, relationships and extensibilities when tested according to the disclosed tests or methods, as best understood. In any case, note again ‘403 recognizes the same problems/solutions, i.e. sustained contact and improvement thereof, and teaches the structure claimed. Therefore it is the Examiner’s second position that even if ‘403 does not teach the exact dimensions, relationships, and extensibilities, the general conditions are disclosed by ‘403 and it is not inventive, i.e. it would be obvious to one of ordinary skill in the art, to discover the optimal or workable dimensions, relationships and extensibilities, as best understood, by routine experimentation, see *In re Aller*, 105 USPQ 233(CCPA 1955).


Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other references also teach members with openings designed to maintain contact with the body.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
January 18, 2006